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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,147	06/27/2003	Kaoru Sakakibara	116348	5167
25944	7590	12/28/2005	EXAMINER	
OLIFF & BERRIDGE, PLC			KAUFFMAN, BRIAN K	
P.O. BOX 19928			ART UNIT	
ALEXANDRIA, VA 22320			PAPER NUMBER	

3765

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/607,147

Applicant(s)

SAKAKIBARA, KAORU

Examiner

Brian K. Kauffman

Art Unit

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 13, 14, 24 and 25 is/are rejected.
- 7) ☒ Claim(s) 4-12 and 15-23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/26/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 25 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed program is not patentable subject matter. It is not associated with the sewing apparatus nor does it produce a tangible result.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by Odermann et al. (4,183,313). Odermann et al. discloses a thread cassette (32, fig. 1) comprising a portion that is engaged by the carrier (34, fig. 4).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3765

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odermann et al. (4,183,313) in view of Sugihara (4,163,997).

In regard to claim 1, Odermann et al. discloses a sewing apparatus in which a thread cassette holding a needle thread wound is used comprising a cassette mount (46) to which the thread cassette (32) is detachably attached; a carrier (34) carrying the thread cassette between an attachment start position and an attachment finish position in the cassette mount (fig. 4, fig. 6); and a control device (40) for controlling the carrier. Claim 1 requires that the control device electrically controls the carrier. Whereas Odermann et al. teaches using mechanical means to control the carrier of a cassette, Sugihara teaches utilizing electrical means to control the carrier of a cassette (col. 6, line 19-col. 8, line 27). Both methods of control are effective methods for performing the same task, which is controlling the carrier of a cassette. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify

Odermann et al.'s device to utilize a control device that electrically controls the carrier as taught by Sugihara because an electrical means for controlling the carrier is a viable alternative to mechanical means for controlling the carrier.

In regard to claims 2-3 and 13-14, Sugihara discloses a supporting member (60) for supporting the cassette, wherein the carrier includes a contact member (32) brought into contact with the cassette, and a driver (69) for moving the contact member, and control device (fig. 1) controls the driver so that the contact member is moved in a predetermined direction in a predetermined amount for insertion of the cassette into the cassette mount.

#### ***Allowable Subject Matter***

Claims 4-12 and 15-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance:

Claims 4-12 and 15-23 are allowable because claims 4-6 and 15 –16 specifically require detectors for detecting the position of the cassette.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

#### ***Response to Arguments***

Applicant's arguments filed 9/27/05 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

In regard to claim 24, the applicant argues that Odermann does not anticipate the invention recited because it does not meet all of the limitation of the claim. The applicant asserts that the examiner's analysis is flawed because Odermann's apparatus has the capability of actuating a control device and the claim requires actually actuating a control device. The applicant goes on to argue that because the claim recites a structure that performs a function, the examiner may not ignore the function. The examiner agrees with the applicant that the examiner cannot ignore the function of the claim, but the examiner asserts that the claim 24 rejection does consider the function.

Claim 24 claims a thread cassette intended to be used in a sewing apparatus. The structural limitations relating to the sewing apparatus including the control device describe the intended use of the thread cassette but are not structural limitations of the thread cassette itself. When determining whether the prior art reads on a claim, it must be determined whether the prior art has the structural limitations recited in the claim and is **capable** of performing the intended use. In this case, the intended use is to be used in a sewing apparatus that has the structural limitation of the preamble and to cause the control device to electrically control the carrier. As was stated in the 6/27/05 office

action, the thread cassette has edge surfaces constituting structure that has the capability, upon being moved by a human operator, to actuate a control device that electrically controls the carrier. Claim 24 recites no structure belonging to the thread cassette itself that is not disclosed by Odermann.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Kauffman whose telephone number is (571)272-4988. The examiner can normally be reached on M-F every week.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on (571)272-4983. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BKK  
12/19/05

  
JOHN J. CALVERT  
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